

Attorney Docket No. 10124/01201

REMARKS

Claims 2, 7, 10 and 19-27 have been cancelled. Claim 1 has been amended. Thus, claims 1, 3 - 6, 8, 9 and 11 - 18 are now pending in the present application. No new matter has been entered. Applicants note with appreciation the allowance of claim 16. In view of the above amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are in condition for allowance.

Claims 1, 3-6, 8, 9, 11-15, 17, and 18 stand rejected under 35 U.S.C. 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner notes that the term "first element guide" lacks antecedent basis. In view of the amendment to claim 1, Applicants submit that this rejection has been obviated.

Claims 1, 3-6, 9, 13, and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,213,957 to Milliman et al. Applicants respectfully disagree. Claim 1 reads as follows:

A biopsy system comprising:

a first placeholder element insertable through tissue to a first selected location in a patient's body, the first placeholder element including a first lumen extending therethrough to a distal opening which, when the first placeholder element is in the first selected location is adjacent to target tissue;

a handle including a channel extending therethrough for receiving the first placeholder element, the channel directing elements inserted thereinto to the first lumen, the handle being removably coupled to the first placeholder element so that the first placeholder element may be left in the first selected location;

a tissue sampling element insertable to the first selected location via the first lumen for obtaining a sample of tissue from the first selected location, the tissue sampling element being removable from the first lumen while leaving the first placeholder element at the first selected location; and

a tissue treatment element insertable to the first selected location via the first lumen.

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The Examiner asserts that housing half sections 512 and 514 meet the recited handle. Claim 1 recites that the handle is "removably coupled to the first placeholder element so that the first placeholder element may be left in the first selected location." Thus, for half sections 512 and 514 to meet the recited handle, they would need to be removably coupled to tissue marker 601, which the Examiner refers to according to its distal end 603 and is believed by him to meet the recited placeholder element. Nevertheless, the Examiner has not cited to any portion of Milliman that describes half sections 512 and 514 as being removably coupled to marker 601. Therefore, it is not the case that these half sections are removably coupled to marker 601.

As noted above, the Examiner asserts that biopsy tissue marker 601 (identified according to its distal end 603 by the Examiner) meets the recited placeholder element. The recited placeholder element includes a first lumen; therefore, for tissue marker 601 to meet the recited placeholder element, it would have to include a lumen. Nevertheless, that is not the case, since Milliman does not state that tissue marker 601 includes a lumen. Unless Milliman describes or illustrates tissue marker 601 as having a lumen, no basis exists for regarding marker 601 as such.

The Examiner also asserts that Milliman teaches a tissue sampling element and a tissue treatment element. Nevertheless, the Examiner does not identify which elements of Milliman meet these elements. Claim 1 recites that these elements are insertable to the first selected location via the lumen of the placeholder element. Milliman does not teach that any element, much less a tissue treating element or a tissue sampling element, is insertable to a location via tissue marker 601, the element asserted as meeting the placeholder element.

Therefore, in view of this discussion, withdrawal of the rejection based on Milliman is requested.

Claims 8, 11, 12, 15, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Milliman in view of U.S. Patent No. 6,497,706 to Burbank. Since Burbank does not overcome the deficiencies noted above with respect to Milliman, withdrawal of this rejection is requested.

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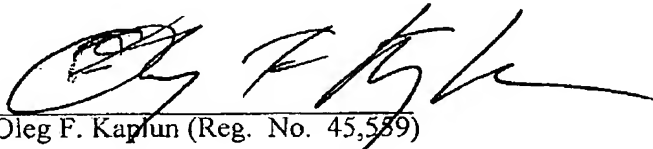
It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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By:


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